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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,423	07/19/2001	Craig Novak	394-137	7272

7590 07/31/2003

Gerard F. Dunne  
156 Fifth Avenue Suite 1223  
New York, NY 10010

EXAMINER

STERLING, AMY JO

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Applicati n No.

09/909,423

Applicant(s)

NOVAK ET AL.

Examiner

Amy J. Sterling

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14 is/are allowed.
- 6) ☒ Claim(s) 17, 18 and 20 is/are rejected.
- 7) ☐ Claim(s) 19, 21, 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This is a non-Final Office Action for application number 09/909,423 Decorative Gift Bag Balloon Holder, filed on 7/19/01. Claims 1-14, 17-22 are pending. Claims 15 and 16 have been cancelled. This Action is in response to applicant's reply dated 5/15/03, paper no. 13.

#### ***Claim Rejections - 35 USC § 112***

The previous rejection under 35 USC 112 is moot in view of the amendments in paper no. 13. With regards to claim 8, the applicant has also explained that the decorative material is held to the core via the inner liner and is not necessarily secured to the core by direct contact. (See Reply, paper no. 13, Page 6, lines 1-7).

#### ***Claim Rejections - 35 USC § 102***

Claim 17 is rejected under 35 U.S.C. 102(b) as being anticipated by United States Patent No. 5441348 to Valentino.

The patent to Valentino discloses a decorative bag having a core (16) formed of a weighty material adapted to hold one or more buoyant balloon in place and positioned within the decorative bag, and decorative material (20) secured within the decorative bag via the core in a position to conceal the core from casual view.

***Claim Rejections - 35 USC § 103***

Claim 18, 20 rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 5441348 to Valentino and in view of United States Patent No. 4930903 to Mahoney.

Valentino shows the basic inventive concept with the exception that it does not teach wherein the core is secured to the interior of the bag.

Mahoney shows a core (14, 48) which is secured to the inside of the interior of a decorative gift bag, used so that the core does not fall out of the bag when moved or tipped. (See Col. 2, lines 46-50). Therefore, it would have been obvious to someone skilled in the art to have modified the core of Valentino to be secured to the bag, in order to make the device less likely to come apart upon moving or tipping the device.

***Response to Arguments***

Applicant has argued that claim 17 is distinguished from Valentino in that the limitation that the decorative material is secured within the decorative bag is not met. This is unpersuasive in that Valentino teaches that the decorative material (20) is secured to the core (16) which is positioned within the decorative bag (See Col. 2, lines 50-54). The decorative material is not secured to the bag, but is secured within the bag, via the core, which meets the limitation of claim 17.

The applicant has also argued that Valentino does not show wherein the core is secured to the interior of the decorative bag, this argument is moot due to the new grounds of rejection above.

***Allowable Subject Matter***

Claims 18, 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-14, 21-22 are allowed. The reason is that the prior art does not show a decorative balloon holder having the handles extending from the upper portion of the bag which are secured together. The prior art of record also does not show that the core is generally trapezoidal in shape to taper towards the upper portion of the decorative bag.

***Conclusion***

The following prior art not relied upon is considered pertinent to the applicant's disclosure

6146018 to Keller et al. shows a decorative bag with a core

Any inquiry concerning this communication should be directed to Amy J. Sterling at telephone number 703-308-3271. The examiner can normally be reached (M-F 8 a.m.-5:00 p.m.). If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leslie Braun can be reached at 703-308-2156. The fax machine number for the Technology center is 703-305-3597 or 703-305-3598 (formal amendments) or 703-308-3519 (informal amendments/communications).

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Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist at 703-308-2168.



AJS  
Amy J. Sterling  
7/28/03



LESLIE A. BRAUN  
SUPERVISORY PATENT EXAMINER